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Clarification
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MARTIN CULLEN

FOR: TILE WET SAW WITH OUTWARDLY DIVERGING CUTTING MODE

SERIAL NO.: 09/864,350

FILED: May 25, 2001

EXAMINER: M. Rachuba, Primary Examiner, Art Unit 3723

**REQUEST FOR CLARIFICATION
AND AMENDMENT OF CLAIM**

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

This is in reference to the Office Action of 03/07/2002.

The claim has been rejected under 35 U.S.C. 102(b) as being anticipated by Sigelich et al. For this to be a valid rejection it would have to be shown that Sigelich et al. discloses or suggests the method of the claim. The examiner states however agreement "that the method of operation of Sigelich et al. [differs] from applicant's method of operation." Following this statement of agreement, the response in the office action is not understood as to the reference "but such is not claimed" (underlining added). If the examiner is contending that applicant's method which is different from the method of operation of Sigelich et al. is not claimed in the claim, this contention is factually incorrect. Sigelich et al. does not read on, disclose or suggest the method steps of lines 9-12, as follows:

“. a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in opposite outward directions until said tile is shaped into two parts,”

The fact that the prior art structure could be modified does not make such a modification obvious in the absence of the prior art suggesting the desirability of doing so (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 984)).

— The refusal of the examiner to acknowledge the differences in the methods disclosed by Sigitich et al. and claimed by applicant without a “structural” difference, does not follow the precedent of In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) and, more particularly, the holding therein that on the issue of anticipation all limitations of a claim must be considered, i.e., the reference to the proposition “the name of the game is the claim,” which appears on the cited page of Hiniker. This position of the examiner, as best understood, also is taken as a rejection under 35 U.S.C. 112, second paragraph which, although not expressly made by the examiner, is nevertheless now addressed by amendment of claim 1.

In claim 1, in line 10, before “proposed” insert --first--; and in line 12, delete “opposite outward directions” and after this deletion insert -- in one direction incident to contact with a length portion of said cutting blade in leading relation to said first cut and incident to contact with a length portion of said cutting blade in trailing relation to said first cut in an opposite direction--.

A marked-up and clean version of amended claim 1 accompanies this reply to the
Office Action.

It is believed that amended claim 1 is allowable over Sigetich et al. and a notice to this effect is earnestly solicited.

Respectfully,

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Dated: March 14, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on March 15, 2002

Dated: 3/15/02

JoAnn Nickich